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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,771	09/05/2003	William N. Schilit	FXPL-1023US1	7229

7590 06/26/2006

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EXAMINER

AUGUSTINE, NICHOLAS

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,771

Applicant(s)

SCHILIT ET AL.

Examiner

Nicholas M. Augustine

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,674,453 in view of Ramanathan et al U.S. Patent No. 6,286,047.

Application 10/655,771	Patent No. 6,674,453
Claim 1: A method for providing access to services when a Web page is accessed by a user comprising the steps of: receiving a URL code from a user;	Claim 1: A method for providing access to services when a Web page is accessed by a user comprising the steps of: receiving a URL code from a user;

retrieving a <u>list</u> of links from the Web page identified by the URL code; displaying the list of links; receiving a user selection of a given one of the links from the list of links; retrieving a list of services which may be performed using the given link, <u>the list of services hosted separately from the list of links</u> ; and displaying the list of services.	retrieving a set of links from the Web page identified by the URL code; displaying the list of links; receiving a user selection of a given one of the links from the list of links; retrieving a list of services which may be performed using the given link; and displaying the list of services, wherein the step of displaying the list of services comprises the steps of: displaying a standard list of services independent of the given link; and displaying one of a number of link dependent services as identified by the given link, wherein the number of link dependent services includes services provided by businesses identified by the links.
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Patent No. 6,674,453 does not teach the list of services hosted separately from the list of links. Ramanathan et al teaches a method in a system where services and web pages containing links is hosted on different servers. (Col. 2, lines 65-67 and Col. 3, lines 1-8) Therefore it would have been obvious to one of ordinary skill in the art at the

Art Unit: 2193

time of the invention to combine the system of Ramanathan et al with the system of Schilit et al. The motivation to combine such systems together is that it there exists a system for delivering content over the web where Ramanathan's system host service and web pages/links on different servers and Schilit's (Pat. No. 6,674,453) system has items (services and links) but no mention of their hosting location of being different from one another (Fig. 1 and Col. 2, lines 65-67 and Col. 3, lines 1-8). Claim 2 in respect to claim 1 is also rejected under obvious provisional double patenting.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1,2,3,8,10, and 13 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Kindberg et al (<http://www.hpl.hp.com/techreports/2000/HPL-2000-16.pdf>).

As to independent claim 1, Kindberg et al discloses a method for providing access to services when a Web page is accessed by a user (Section 2.1, Page 3, Paragraph 6 and S. 2.4, pg. 6, lines 8-11) comprising the steps of: receiving a URL code from a user (S. 3.2.1, pg. 8, par. 1); retrieving a list of links from the Web page

Art Unit: 2193

identified by the URL code (Fig. 4 and S.2.1, pg.3, par. 5 and S.2.4, pg. 6, par. 2); displaying the list of links (Fig. 4 and Bookstore, Van Gogh Bedroom); receiving a user selection of a given one of the links from the list of links (S.2.1, pg. 4, par. 3); retrieving a list of services which may be performed using the given link (S.2.4, pg. 6, par. 2 and S.2.1, pg. 4, par. 3), the list of services hosted separately from the list of links (S.2.2, pg. 4, par. 5 and Fig. 6); and displaying the list of services (S.2.4, pg. 6, par. 2 and S.3.2.1, pg. 8, par. 4 and 5).

As to dependent claim 2, Kindberg et al discloses the method of claim 1, wherein the step of displaying the list of services comprises the step of: displaying a standard list of services independent of the given link (S.3.2.1, pg. 8, par. 4,5 and S.2.1, pg.4, par. 3); and displaying one of a number of link dependent services as identified by the given link (S.3.2.1, pg. 8, par. 4,5 and S.2.1, pg.4, par. 3).

As to dependent claim 3, Kindberg et al discloses the method of claim 2, wherein the standard list of services consists of one or more of the following: printing the Web page identified by the given link (S.2.4, pg. 6, par. 2); faxing the Web page identified by the given link; emailing the given link; displaying the contents of the Web page identified by the given link (Fig.4); transmitting the given link as a pager message.

As to dependent claim 8, Kindberg et al discloses the method of claim 1, wherein the standard list of services consists of one or more of the following: printing the Web page identified by the given link (S.2.4, pg. 6, par. 2); faxing the Web page identified by the given link; emailing the given link; displaying the contents of the Web page identified by the given link (Fig.4); transmitting the given link as a pager message.

As to dependent claim 10, Kindberg et al discloses the method of claim 1, wherein the step of displaying the list of services comprises the step of: displaying a standard list of services (S.3.2.1, pg. 8, par. 4,5 and S.2.1, pg. 4, par. 3); and displaying a list of services dependent on a location of the mobile device from a location of where the services can be performed relative to the user (S.2.1, pg. 3, par. 5).

As to dependent claim 13, Kindberg et al discloses the method of claim 1, wherein the step of displaying the list of services comprises the step of: displaying a standard list of services (S.3.2.1, pg. 8, par. 4,5 and S.2.1, pg. 4, par. 3); and displaying a list of services dependent on a characteristic of the user (S.2.1, pg. 3, par. 5).

Conclusion

Art Unit: 2193

* Embedding web access mechanism in an appliance for user interface functions including a web server and web browser, US Patent No. 5956487 (September 21, 1999). Inventors: C. Venkatraman and J. Morgan, Assignee: Hewlett-Packard Company, Palo Alto, CA.

* Erik Guttman, Service Location Protocol: Automatic Discovery of IP Network Services, IEEE Internet Computing, v.3 n.4, p.71-80, July 1999

* Petros Maniatis , Mema Roussopoulos , Ed Swierk , Kevin Lai , Guido Appenzeller , Xinhua Zhao , Mary Baker, The mobile people architecture, ACM SIGMOBILE Mobile Computing and Communications Review, v.3 n.3, p.36-42, July 1999

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas M. Augustine whose telephone number is 571-272-1056. The examiner can normally be reached on M-TR: 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on 571-272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2193

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas Augustine
Examiner
Art Unit 2193

N. Augustine
May 25, 2006


CHANH NGUYEN
PRIMARY EXAMINER